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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,296	09/01/2000	Peter Schneider	P00,0634	2783

7590

04/16/2004

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6600 Sears Tower
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Chicago, IL 60606-6473

EXAMINER

HSU, ALPUS

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 04/16/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/623,296

Applicant(s)

SCHNEIDER ET AL.

Examiner

Alpus H. Hsu

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 2665

1. The U.S. Patent No. 5,168,546 cited in IDS Form PTO 1449 appears to be in error since it is irrelevant to the claimed invention and therefore is withdrawn from consideration by the examiner. The correct U.S. Patent No. should be **5,168,564** instead.
2. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claimed feature of an apparatus for immediately outputting response of a synchronous system to an asynchronous event utilizing an advanced calculation unit that calculates responses of the synchronous system to possible asynchronous events and a switching device that selectively passes an output signal either from the advanced calculation unit or the synchronous system contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. To be more specific, according to the detailed description of the figure, it is the synchronous system (1) with output signal E2, the advanced calculation unit (2) with output signal E1, and the switching device (3) with output signal A and control signal C was described. But there is no disclosure as to what the input signals for the synchronous system and the advanced calculation unit are and where the input signals for the synchronous system and the advanced calculation unit and the control signal for the switching device are coming from. Furthermore, it is also not fully disclosed as to how the asynchronous events can be calculated in advance, and how the input signals for the synchronous system and

Art Unit: 2665

the advanced calculation unit and the control signal for the switching device are correlated to one another for enabling the claimed apparatus to work properly and functionally.

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 1-2, "the response" lacks antecedent basis; line 9, "calculation device" should be changed to -- calculation unit -- for consistency in claim language.

In claim 6, line 6, "calculation device" should be changed to -- calculation unit -- for consistency in claim language.

In claim 7, line 3, "calculation device" should be changed to -- calculation unit -- for consistency in claim language.

4. Due to the nature of 112, first paragraph problem indicated in paragraph 2 above, there is no prior art rejection can be applied at this time.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Conrad et al., Cox et al., Wang et al. and Cantrell et al. are cited to show the common feature of synchronizer circuit for synchronizing asynchronous signal with synchronous signal utilizing logic circuitry similar to the claimed invention.

Cook and Brief are cited to show the common feature of managing synchronous event and asynchronous event in a computer system similar to the claimed invention.

Art Unit: 2665

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (703)305-4377. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on (703)308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHH



Alpus H. Hsu
Primary Examiner
Art Unit 2665